

OCT 18 2006

Patent Application  
U.S. Application No.: 10/022,438  
Attorney Docket No.: 52493.000230**REMARKS**

The Office Action dated May 18, 2006, has been received and carefully considered. By this Amendment, claims 1-6, 9-17, 20-24 are pending, claims 7-8 and 18-19 have been canceled by previous amendment, and claims 22-24 are added. No new matter has been entered by this Amendment. Support for the added claims may be found in paragraphs 0054 and 0065, for example.

Reconsideration of the outstanding rejections in the present application is respectfully requested based on the following remarks.

**I. THE INDICATION OF ALLOWABLE SUBJECT MATTER**

In the Office Action, claim 21 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant appreciates the indication of allowable subject matter in the Office Action. In view of the arguments set forth below regarding claim 1, from which claim 21 depends, such claim 21 has not at this time been placed into independent form.

**II. THE 35 U.S.C. §102 REJECTION BASED ON BARTON**

In the Office Action, claims 1-5, 9-16, and 20 are rejected under 35 U.S.C. 102(c) as being anticipated by Barton et al. (U.S. 2002/0059093), hereinafter "Barton." This rejection is respectfully traversed.

In paragraph 7, the Office Action sets forth the basis of the rejection as to claim 1. The Office Action asserts that as per claim 1, Barton teaches a method for use in compliance management, comprising: presenting, via a computer network, at least one user with a series of

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questions relating to at least one business category (See figure 11, paragraphs 0010, 0012-4, 0049, 0051, wherein questions are presented via the network concerning compliance risk); soliciting, via the computer network, a response from the at least one user for each question presented (See paragraphs 0010, 0012-4, 0049, 0051, 0060, wherein the questions are answered); determining a detection index based on the number of responses to each of the series of questions (See paragraphs 0081 and 0084, wherein detection is determined); determining an occurrence index based on the potential consequence of non-compliance (See paragraphs 0007, 0081, and 0084, wherein occurrence index is determined); determining a standard severity risk index based on the expected severity of noncompliance (See paragraphs 0068, 0072-3, 0075, 0081, 0084, wherein severity indexes are considered); and prioritizing, via the computer network, the at least one business category based on the at least one user's responses and at least one total risk score comprising the product of the detection, occurrence, and standard severity risk indices (See paragraphs 0081, 0084-7, wherein a risk score is calculated based on these factors. See also paragraphs 0068-9, 0072, 0081, 0090-1, where risk prioritization numbers are generated to determine the order to handle the risk areas of the business).

Applicant respectfully submits that Barton fails to teach each and every feature of claim 1. As set forth in the listing of claims above, claim 1 is directed to a method for use in compliance management. Various features of the claimed method are set forth, as well as the interrelationship between those features. In particular, claim 1 recites the feature of "determining an occurrence index based on the potential consequence of non-compliance". Accordingly, claim 1 does not merely recite determining an occurrence index, but recites a particular manner in which the occurrence index is determined, i.e., that the occurrence index is

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based on a potential consequence of non-compliance. Applicant submits that Barton fails to teach such specifics.

As noted above, the Office Action asserts that Barton teaches determining an occurrence index based on the potential consequence of non-compliance (See paragraphs 0007, 0081, and 0084, wherein occurrence index is determined). However, Applicant respectfully submits that such assertion in the Office Action is indeed reflective of an inappropriate minimization of the claim language. Indeed, claim 1 does not merely reflect that an occurrence index is determined, but rather that an occurrence index is determined in a particular manner. Barton fails to teach such specifics.

Applicant notes that Barton is directed to methods and systems for compliance program assessment. In the Abstract, Barton teaches methods and systems for identifying and quantifying compliance issues. Barton describes that in one embodiment, a system is configured to implement a method which comprises assessing at least one compliance program to identify potential risks and prioritizing the potential risks. The issues relating to the potential risks, for example, failure modes and root causes are identified and are mitigated and controlled.

As to the above feature relating to determination of the occurrence index, the Office Action cites paragraphs 0007, 0081, and 0084. Paragraph 0007 of Barton describes that the Barton invention facilitates proactive monitoring and measuring of compliance with company policies so that appropriate action can be taken to avoid an occurrence of non-compliance. In one aspect, a method is provided for conducting a consistent, documented and yet repeatable compliance risk assessment and mitigation process. The method can be practiced using a network-based system including a server system coupled to a centralized database and at least

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one client system. Barton teaches the method comprises the steps of conducting a compliance program assessment, conducting a prioritization of compliance risks, identifying potential compliance failures including causes and effects and ensuring that risk monitoring and control mechanisms are in place to mitigate compliance risks.

Further, Applicant notes that referenced paragraph 0081 talks further to risk related processing. In particular, Barton teaches, with reference to Fig. 14, high-risk process steps are mapped 202 and a failure mode and effects analysis matrix (FMEA) is constructed. In constructing the FMEA a severity rating, current controls in place are listed 210, a likelihood of occurrence factor and a detection ability factor is assigned 212 based on a standard rating system which is part of the knowledge base in server 12. Server 12 is configured to use the rating system and the entered factors to calculate 214 risk prioritization numbers (RPNs). However, these features fail to teach the particulars of claim 1.

Further, paragraph 0084 of Barton teaches:

[0084] Severity rating, occurrence and detection factors previously assigned 212 (shown in FIG. 14), also are part of FMEA matrix 230. In one embodiment, the severity-rating for the QFD matrix during prioritization of the risk is entered into a severity rating column 246 in FMEA matrix 230. *Then, the values for occurrence and detection are calculated using any standard rating system. In one embodiment, the standard rating system includes values from one to ten.. An occurrence factor measures the likelihood of occurrence of non-compliance. The likelihood of occurrence measures the frequency of non-compliance in the process with a value of one indicating a remote likelihood up to a value of ten representing that failure is assured. The ability to detect (detection) uses a similar numerical scheme with a value of one meaning that if there is noncompliance, the potential failure will be found or prevented to a value of ten representing absolute certainty that current controls will not detect potential failures or there are no controls in*

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place. The severity rating, occurrence and detection factors are then entered into the FMEA matrix 230 under a severity column 246, an occurrence column 248, and a detection factor column 250 respectively. (Emphasis added)

Of particular note, Applicant notes that Barton teaches that "the values for occurrence and detection are calculated using any standard rating system." Applicant submits that such disclosure of Barton reflects the general nature of the "occurrence" determination of Barton. Such teachings of Barton, as well as the other disclosure of Barton, fail to teach the specifics of claim 1 as set forth above. In particular, Barton fails to teach the feature of "determining an occurrence index based on the potential consequence of non-compliance". This is true especially in the context of the other claimed features of claim 1.

For at least the reasons set forth above, Applicant submits that claim 1 defines patentable subject matter. Further, claim 10 defines patentable subject matter at least for reasons similar to claim 1.

Applicant submits that the dependent claims recite patentable subject matter at least for their various dependencies on claims 1 and 10, as well as for the additional subject matter recited in such dependent claims. Claims 22-24 are added to recite further novel features of the invention.

The applied art to Barton fails to teach or suggest such claimed features. Withdrawal of the 35 U.S.C. §102 rejection is respectfully requested.

### III. THE 35 U.S.C. §103 REJECTION BASED ON BARTON

In the Office Action, claims 6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barton. This rejection is respectfully traversed.

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As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With reference to claim 6, the Office Action alleges that Barton teaches various features, as is set out in the Office Action. However, the Office Action reflects that Barton does not expressly disclose using the number of questions presented to determine a detection index.

In an attempt to address such deficiency, the Office Action sets out that Barton discloses a detection index being determined which is used to determine a risk score; and that Barton also discloses using information concerning the number of questions presented (and response opportunities) to score risk.; and using the number of questions presented as a baseline for frequency of response is well known in surveys. The Office Action then concludes therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the number of questions presented (i.e. opportunities) when calculating the detection index in order to more efficiently determine the potential for failure concerning a business risk by judging the frequency of response.

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Applicant respectfully submits that even if such modification were obvious, which is not admitted, such modification of Barton would fail to address the deficiencies of Barton as set forth above.

Accordingly, Applicant submits that claims 6 and 17 are allowable based on their dependency on claims 1 and 10, as well as for the further features claims 6 and 17 recite. Withdrawal of the rejection under 35 U.S.C. §103 is requested.

#### IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

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fees to the same deposit account.

Respectfully submitted,

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